

## **II. REMARKS/ARGUMENTS**

These Remarks are in reply to the Final Office Action mailed May 11, 2005 (hereafter, "Final Office Action").

Claims 1-7 and 9-13 were pending in the Application prior to the outstanding Final Office Action. The Final Office Action rejected claims 1-7 and 9-13. The present Reply demonstrates the patentability of all currently pending claims, leaving for the Examiner's consideration claims 1-7 and 9-13.

### **I. Amendments to Claims**

Although no objections were raised to claims 4, 5, and 6 on grounds of indefiniteness under 35 U.S.C. § 112, Applicants have amended claims 4, 5, and 6 to correct the step designator from (d) to (e) in each claim, thereby making the claim more fully consistent with the specification, and promoting greater definiteness.

### **II. Response to Rejections**

The Final Office Action rejected claims 1-2, 3, 5-7 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Slotte et al. (U.S. Patent No. 6,408,063; hereinafter, *Slotte*). The Final Office Action rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Slotte* in view of Yamashita (U.S. Patent No. 6,470,196; hereinafter, *Yamashita*) or Bremer (U.S. Patent No. 6,018,671; hereinafter, *Bremer*) and further in view of Levy et al. (U.S. Patent No. 4,577,067; hereinafter, *Levy*) or Saito (U.S. Patent No. 6,526,263; hereinafter, *Saito*). The Final Office Action rejected claims 9-11 under 35 U.S.C. § 103(a) as being unpatentable over *Slotte* in view of *Yamashita* or *Bremer* and further in view of Zahavi et al. (U.S. Patent No. 6,577,859; hereinafter, *Zahavi*). The Final Office Action rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *Slotte* in view of *Zahavi* and further in view of *Yamashita* or *Bremer*. Applicants respectfully traverse these rejections.

The present invention discloses a system for a telephone that generates audible utterances for a remote listener in an ongoing conversation. Independent claim 1 discloses a system for a telephone, comprising: (a) a mechanical device associated with a conversation element; (b) a memory, coupled

to the mechanical device, for storing an internal conversation element representing an audible utterance for a remote listener in an ongoing conversation; (c) a processor, coupled to the memory and the mechanical device, for generating the audible utterance in response to a user interaction with the mechanical device and the conversation element; and (d) a second mechanical device associated with ending a quiet mode; wherein the processor, in response to user interaction with the second mechanical device is configured to accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone. The internal conversation element derives from an *ongoing* conversation between at least two *live people*. A user interacts with the device and the conversation element to generate an audible utterance in real time.

Similarly, independent claim 7 discloses a system for a telephone, comprising: (a) a plurality of mechanical devices associated with conversation elements; (b) a memory, coupled to the plurality of mechanical devices, for storing a plurality of internal conversation elements, each internal conversation element representing an audible utterance to be transmitted to a remote listener in an ongoing conversation; (c) a processor, coupled to the memory and the plurality of mechanical devices, the processor for generating an audible utterance in response to a user selection of a mechanical device from the plurality of mechanical devices; and (d) wherein the processor, in response to user interaction with the plurality of mechanical devices is configured to end a quiet mode and accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone. The internal conversation elements derive from *ongoing* conversations between at least two *live people*. A user interacts with the device and the conversation elements to end a quiet mode and accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone.

Independent claim 13 discloses a system for a telephone, comprising: (a) a plurality of mechanical devices associated with conversation elements; (b) a memory, coupled to the plurality of mechanical devices, for storing a plurality of internal conversation elements, each internal conversation element representing an audible utterance to be transmitted to a remote listener in an ongoing conversation; (c) a processor, coupled to the memory and the plurality of mechanical devices, the processor for generating an audible utterance in response to a user selection of a mechanical device from the plurality of mechanical devices; and (d) wherein the processor, in

response to user interaction with the plurality of mechanical devices is configured to end a quiet mode and accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone. The plurality of internal conversation elements represents audible utterances to be transmitted to a remote listener in an *ongoing* conversation between at least two *live people*. A user selects a mechanical device from the plurality of mechanical devices and in response the processor ends a quiet mode and accepts audible utterances from a party local to the telephone and transmits the accepted audible utterances through the telephone in real time.

None of the cited references disclose or suggest the features of the claimed invention. The three cited references, *Slotte*, *Yamashita*, and *Bremer*, considered singly or in combination, fail to disclose all of the limitations of independent claims 1, 7, and 13. Similarly, *Slotte*, *Zahavi*, *Yamashita*, and *Bremer*, considered singly or in combination, fail to disclose all of the limitations of independent claim 13. *Slotte* discloses a method for complementing a telephone connection with additional information. A first telecommunication device transmits to a second telecommunication device a request for setting up a telephone connection. (Abstract). The receiver of the first signaling message makes a decision about how to handle the call on the basis of the information received in the signaling message. (Abstract) *Slotte* discloses an invention designed for a person that wishes to transmit call-related information along with a telephone call (col. 2, lines 30-36). No live user is necessarily present at the receiving end during the operation of the invention, and no conversation taking place between two people in real time is disclosed, let alone a conversation taking place between two people in real time in which audible utterances are generated. *Slotte* can therefore in no way be equated with the current invention.

The first cited sections of *Slotte* disclose (figs., col. 3, lines 19-22) that User-to-User signaling is used to convey certain caller- and/or receiver-related information between the calling party and the called party in the beginning of a call, ~~during~~ during a call and/or at the end of a call. The first cited sections of *Slotte* further disclose (figs., col. 3, lines 22-25) that the transmitted information is used in the other end to manually and/or automatically evaluate some features that are helpful in deciding how to handle the call. The final cited section of *Slotte* (col. 10 line 28-col. 11) discloses as an example, a situation where B is in a meeting and has set his mobile telephone into silent mode,

according to both manual and automatic embodiments. These disclosures of *Slotte* can therefore in no way be equated with the disclosures in independent claims 1, 7, and 13.

By the same token, *Bremer* discloses a remote device that includes a silent alert allowing the device to signal the user of an incoming call without an audible alert. (Abstract and col. 1, lines 56-58). The device further includes a key to accept the call into a *nonactive* state, after which a *prerecorded* message is generated from memory and played for the calling party to inform the caller that the user is occupied but will answer the call shortly. (Abstract and col. 1, lines 58-60) According to *Bremer*, operation of the invention terminates once the user (recipient of the call) enters the activate call state, i.e., initiates a real-time phone conversation with the caller (Abstract and col. 1, lines 62-67). No conversation taking place between two people in real time is disclosed, let alone a conversation taking place between two people in real time in which audible utterances are generated. *Bremer* can therefore in no way be equated with the current invention.

The first cited section of *Bremer* discloses (col. 1, line 55-col. 1, line 57) a remote device including a silent alert allowing the remote device to signal the user of an incoming call without an audible alert. The first cited section of *Bremer* further discloses (col. 1, line 57-col. 2, line 5) that the remote device further includes a key actuated by the user to put the caller on hold. The final cited sections of *Bremer* (cols. 3-5, col. 3, lines 29-35) disclose that the user accepts the call into an active call state upon generating a signal to controller. The final cited sections of *Bremer* (cols. 3-5, col. 3, lines 35-39) further disclose that if the remote device does not have folding housing sections, the silent answer key 119 or one of the keys in key set 118 is manually actuated to generate a signal to the controller 110 indicating that the user wants to enter an active call state to converse with the caller.

Contrary to the suggestion of the Final Office Action, the quiet mode key and the control key are elements of the *same* mechanical device (see fig. 2) and therefore, in contrast to claim 1, make no disclosure relating to a processor configured to accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone *second* mechanical device associated with ending a quiet mode. Similarly, these keys are elements of the *same* mechanical device (see fig. 2) and, in contrast to claim 7, make no disclosure relating to a processor configured to end a quiet mode and accept audible utterances from a party local to the telephone and

transmit the accepted audible utterances through the telephone in response to user interaction with a *second* mechanical device associated with ending a quiet mode. These disclosures of *Bremer* can therefore in no way be equated with the disclosures in independent claims 1, 7, and 13.

Similarly, *Yamashita* discloses a portable communication apparatus which can stop the alert indicating the occurrence of an incoming call while holding the incoming call so that the calling party does not disconnect the call. (Abstract and col. 2, lines 7-10). The invention is directed to a caller who is on hold. (Abstract and col. 10, lines 25-54). *Yamashita* makes no disclosure relating to a live user at the receiving end during the operation of the invention, and no conversation taking place between two people in real time is disclosed, let alone a conversation taking place between two people in real time in which audible utterances are generated. *Yamashita* can therefore in no way be equated with the current invention.

The cited sections of *Yamashita* disclose (figs. and col. 7 lines 51-57) that when the response key is depressed, the display alert is stopped and the control goes to the communication mode allowing conversation between the calling and called parties, since the alert is stopped in the quick-silence function ON state, only the start key functions as the response key as shown in FIG. 3. These disclosures of *Yamashita* can therefore in no way be equated with the disclosures in independent claims 1, 7, and 13.

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disclosures of *Yamashita* can therefore in no way be equated with the disclosures in independent claims 1, 7, and 13.

Similarly, with regard to claim 13, *Zahavi* discloses a system and method which allows a cellular phone user to communicate with a caller when the user is unable to speak aloud. a second telecommunication device a request for setting up a telephone connection. (Abstract). The method comprises the steps of establishing a wireless communication link between a wireless terminal user and a second party and selectively activating at the wireless terminal the transmission of at least one audible message for receipt by the second party, wherein the audible message is responsive to a message transmitted by the second party. (Abstract) *Zahavi* makes no disclosure relating to a processor configured, in response to user interaction with a *plurality* of mechanical devices, to end a quiet mode and accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone. *Zahavi* can therefore in no way be equated with the current invention.

The first, third, fourth, and fifth cited sections of *Zahavi* disclose (col. 5, col. 5-6, fig. 2, col. 6 lines 11-15) that an introduction message may be either a standardized system greeting or a personalized message pre-recorded by the user. The second cited section of *Zahavi* discloses (col. 2, lines 45-67, at lines 63-67) a terminal configured to have two such keys or menu items positioned on the (*same*) wireless terminal so as to be selected by the wireless terminal user without removing the terminal from the user's ear. These disclosures of *Zahavi* can therefore in no way be equated with the disclosures in independent claim 13.

Therefore none of the cited references, considered singly or in combination, discloses the limitations of independent claim 1 regarding (a) a mechanical device *associated with a conversation element*; (b) a memory, coupled to the mechanical device, for storing an internal conversation element representing an *audible utterance* for a remote listener in an *ongoing conversation*; (c) a processor, coupled to the memory and the mechanical device, for *generating the audible utterance in response to a user interaction* with the mechanical device and the conversation element; and (d) wherein the processor, in response to user interaction with the *second* mechanical device, is configured to end a quiet mode and accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone.

Similarly, none of the cited references, considered singly or in combination, discloses the limitations of independent claim 7 regarding (a) a plurality of mechanical devices *associated with conversation elements*; (b) a memory, coupled to the plurality of mechanical devices, for storing a plurality of internal conversation elements, each internal conversation element representing an *audible utterance* to be transmitted to a remote listener in an *ongoing conversation*; (c) a processor, coupled to the memory and the plurality of mechanical devices, the processor for *generating an audible utterance in response to a user selection* of a mechanical device from the plurality of mechanical devices; and (d) wherein the processor, in response to user interaction with the *plurality* of mechanical devices is configured to end a quiet mode and accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone.

Similarly, none of the cited references, considered singly or in combination, discloses the limitations of independent claim 13 regarding (a) a plurality of mechanical devices associated with conversation elements; (b) a memory, coupled to the plurality of mechanical devices, for storing a plurality of internal conversation elements, each internal conversation element representing an audible utterance to be transmitted to a remote listener in an ongoing conversation; (c) a processor, coupled to the memory and the plurality of mechanical devices, the processor for generating an audible utterance in response to a user selection of a mechanical device from the plurality of mechanical devices; and (d) wherein the processor, in response to user interaction with the plurality of mechanical devices is configured to end a quiet mode and accept audible utterances from a party local to the telephone and transmit the accepted audible utterances through the telephone.

Moreover, with respect to the rejections of all currently pending claims, the Final Office Action cites no motivation to combine the references. The Final Office Action provides *benefits* for combining the references, but demonstrates no motivation, either explicit or implicit, in any of these references for combining them. The law is clear that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). The Federal Circuit has held, “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious *unless the prior art suggested the desirability of the*

*modification..... it is impermissible to use the claimed invention to piece together the prior art so that the claimed invention is rendered obvious". In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992).*

Moreover, the Final Office Action appears to use impermissible hindsight in reaching its conclusions regarding obviousness. To reach a proper determination under 35 U.S.C. § 193, the Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. Manual of Patent Examining Procedure (hereafter, "MPEP") § 2142.

Applicants respectfully note that while it may or may not be, as repeatedly suggested by the Final Office Action (p. 2, 4<sup>th</sup> para.; p. 4, 2<sup>nd</sup> para; and p. 7, last para.), "notoriously well known in the art to put a call on hold during the call reception or during the middle of a call and then deactivating the quiet mode to talk to a caller," this suggestion is irrelevant to the inventive elements of the current claims. The current claims are not directed to putting a call on hold during the call reception or during the middle of a call and then deactivating a quiet mode to talk to a caller, as when a caller is on hold, by definition only one live person is present and no conversation can occur. By contrast, the current claims are directed to a method and system for generating audible utterances in response to user input during a *live, real time, two-way* phone conversation.

The references cited in the Final Office Action, considered singly or in combination, fail to disclose all of the limitations of independent claims 1, 7 and 13. Claims 2-6 and 9-12 each ultimately depend from one of the independent claims and are believed patentable for at least the same reasons as the independent claims and because of the additional limitations of these claims.

Accordingly, claims 1-7 and 9-13 are believed patentable over the cited references and withdrawal of the rejections is respectfully requested.



### III. CONCLUSION

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: 7/11/05

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